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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LAU, JONATHAN S

ART UNIT

PAPER NUMBER

1623

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/577,970	Applicant(s) SUGIHARA ET AL.	
	Examiner Jonathan S. Lau	Art Unit 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 9-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 1-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7 pgs / 03 Mar 2006, 16 Jun 2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application is the national stage entry of PCT/JP04/17031, filed 10 Nov 2004; and claims benefit of foreign priority document JAPAN 2003-380194, filed 10 Nov 2003; currently an English language translation of this foreign priority document has not been made of record.

Claims 1-27 are pending in the current application. Claims 9-27, drawn to non-elected inventions, are withdrawn. Claims 1-8 are examined on the merits herein.

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-8, in the reply filed on 29 Dec 2008 is acknowledged. The traversal is on the ground(s) that the inventions are related as method of making the invention of Group I and a use of the invention of Group I. This is not found persuasive because the common feature is a known product. Applicant's remarks regarding rejoinder upon a finding of allowable subject matter is acknowledged.

The requirement is still deemed proper and is therefore made FINAL.

Claims 9-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in the reply filed on 29 Dec 2008.

Claim Objections

Claims 6-8 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent may not depend from another multiple dependent claim, for example instant claims 4 and 5. See MPEP § 608.01(n). Accordingly, the claims 6-8 have not been further treated on the merits.

Claims 1-5 are objected to because of the following informalities: Claim 1 recites the transitional phrase "comprising polysaccharide and water as essential components..." It is unclear if this is intended to have the meaning of the transitional phrase "consisting essentially of" or "comprising". Because the term "comprising" is used, this phrase is interpreted as "comprising".

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The specification discloses chemicals, such as agar at page 22, paragraph 2

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which meet the written description and enablement provisions of 35 USC 112, first paragraph. However, claims 1-5 are directed to encompass polysaccharide-containing compositions, which only correspond in some undefined way to specifically instantly disclosed chemical compositions. None of these polysaccharide-containing compositions meet the written description requirement of 35 USC 112, first paragraph, due to lacking chemical structural information for what they are and because chemical polysaccharide-containing compositions are highly variant and encompass a myriad of possibilities. The specification provides insufficient written description to support the genus encompassed by the claim.

The recitation, “characterized in that an amount of precipitated polysaccharide after performing centrifugal separation at 25 °C with 40,000x g for one hour is less than” 65, 55 or 30 wt % of a total polysaccharide content, is seen to be merely functional language.

Functional language at the point of novelty, as herein employed by Applicants, is admonished in *University of California v. Eli Lilly and Co.* 43 USPQ2d 1398 (CAFC, 1997) at 1406: stating this usage does “little more than outline goal appellants hope the recited invention achieves and the problems the invention will hopefully ameliorate”. The CAFC further clearly states that “[A] written description of an invention involving a chemical genus, like a description of a chemical species, requires a precise definition, such as by structure, formula, [or] chemical name, of the claimed subject matter sufficient to distinguish it from other materials” at 1405(emphasis added), and that “It does not define any structural features commonly possessed by members of the genus

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that distinguish from others. One skilled in the art therefore cannot, as one can do with a fully described genus, visualize or recognize the identity of the members of the genus. A definition by function, as we have previously indicated, does not suffice to define the genus.." at 1406 (emphases added).

Thus, Applicants functional language at the points of novelty fails to meet the requirements set forth under 35 U.S.C. 112, first paragraph. Claims employing functional language at the exact point of novelty, such as Applicants', neither provide those elements required to practice the inventions, nor "inform the public during the life of the patent of the limited of monopoly asserted" (*General Electric Company v. Wabash Appliance Corporation et al.* 37 USPQ at 468 (US Supreme Court 1938)).

Vas-Cath, Inc. v. Mahurkar, 935 F.2d 935 F.2d 1555, 1563 [19 USPQ2d 1111] (Fed. Cir. 1991), makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (*Vas-Cath* at page 1116.)

With the exception of the above specifically disclosed chemical structures, the skilled artisan cannot envision the detailed chemical structure of the encompassed polysaccharide-containing compositions, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. The

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chemical structure itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601, 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016. In *Fiddes v. Baird*, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence. The court of *University of California v. Eli Lilly and Co.*, 119 F.3d 1559 [43 USPQ2d 1398] (Fed. Cir. 1997) held that:

...To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) ("[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966.

The court of *In re Curtis* held that "a patentee will not be deemed to have invented species sufficient to constitute the genus by virtue of having disclosed a single species when... the evidence indicates ordinary artisans could not predict the operability ... of any other species." See *In re Curtis* 354 F.3d 1347 [69 USPQ2d 1274] (Fed. Cir. 2004). The court of *Noelle v. Lederman*, 355 F.3d 1343 [69 USPQ2d 1508] (Fed. Cir. 2004) also pointed out that generic claim to anti-CD40CR Mabs lacked written description support because there was no description of anti-human or other species Mabs, and no description of human CD40CR antigen. The court further pointed out that attempt to "define an unknown by its binding affinity to another unknown" failed. The court of *Carnegie Mellon Univ. v. Hoffman-LaRoche Inc.*, 541 F.3d 1115, 1125 [88 USPQ2d 1233] (Fed. Cir. 2008) held that the written disclosure requirement was not met where the claims at issue covered a broad "genus of recombinant plasmids that contain coding

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sequences for DNA polymerase ...from any bacterial source, [but] the narrow specifications of the[relevant patents] only disclose[d] the ... gene coding sequence from one bacterial source”

Therefore, only the structurally defined chemical compositions, but not the full breadth of the claims, meet the written description requirement of 35 USC 112, first paragraph. The species specifically disclosed are not representative of the genus because the genus is highly variant. Applicant is reminded that *Vas-Cath* makes clear that the written description requirement of 35 USC 112 is severable from its enablement provision. (See *Vas-Cath* at page 1115.)

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the polysaccharide agar, does not reasonably provide enablement for all polysaccharides. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The Applicant's attention is drawn to *In re Wands*, 8 USPQ2d 1400 (CAFC1988) at 1404 where the court set forth eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApls 1986) at 547 the court recited eight factors:

(1) The nature of the invention; (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the

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claims; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary.

Nature of the invention: A polysaccharide-containing composition comprising polysaccharide and water as essential components, characterized in that an amount of precipitated polysaccharide after performing centrifugal separation at 25 °C with 40,000x g for one hour is less than 65 wt % of a total polysaccharide content.

The state of the prior art: Johnson et al. (Cereal Chemistry, 1975, 52, p70-78, cited in PTO-892) discloses within the narrow subgenus of maltooligosaccharides the reported values of physical properties of the fractions vary widely due to difficulty in obtaining pure fractions (page 70, paragraph 1). Johnson et al. discloses numerous investigators have measured physical and chemical properties of maltooligosaccharides but their data do not agree well (page 70, paragraph 3).

Marchal et al. (Trends in Food Science & Technology, 1999, 10, p345-355, cited in PTO-892), also drawn to the maltooligosaccharides of maltodextrin, discloses that the dextrose equivalent, or the number of glucose molecules in the polysaccharide, of a maltodextrin has been shown to be inadequate to predict product performance in various applications, suggests this may be due to a distribution of linear and branched saccharides, and notes that maltodextrins with the same dextrose equivalent can have different properties that reflect differences in their molecular composition (page 345, right column, section **Introduction**).

The relative skill of those in the art: The relative skill of those in the art is high.

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The predictability or unpredictability of the art: While the amount of precipitated polysaccharide from a polysaccharide-containing composition after performing centrifugal separation at 25 °C with 40,000x g for one hour can be determined according the recited method of separation, the sheer number of polysaccharides of different carbohydrate constitution, branching patterns and chain lengths means that one skilled in the art cannot predict the properties for all possible polysaccharide-containing compositions. The there is no established structure-function correlation from which the functional property of the amount of precipitated polysaccharide from a polysaccharide-containing composition after performing centrifugal separation at 25 °C with 40,000x g for one hour may be used to predict structural information across the broad genus of all possible polysaccharides. Therefore the claimed invention is unpredictable.

The Breadth of the claims: The scope of the claims is infinite. Any possible polysaccharide could potentially be used in the instant polysaccharide-containing composition.

The amount of direction or guidance presented: The specification speaks generally about carbohydrates, at page 11. Specific examples of polysaccharides, such as agar, agarose and chitin are suggested. However, guidance is not given for how the structure of these polysaccharides correlates to the claimed functional property.

The presence or absence of working examples: The only working examples provided are for agar having a average molecular weight of about 90,000 at page 22, paragraph 2.

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Note that lack of working examples is a critical factor to be considered, especially in a case involving an unpredictable and undeveloped art such as the precipitation behavior of the genus of polysaccharides from polysaccharide-containing compositions. See MPEP 2164.

The quantity of experimentation necessary: In order to practice the invention with the full range of all possible polysaccharides beyond those known in the art, (such as agar having a average molecular weight of about 90,000) one skilled in the art would undertake a novel and extensive research program into the precipitation behavior of the genus of polysaccharides from polysaccharide-containing compositions. Because this research would have to be exhaustive, and because it would involve such a wide and unpredictable scope of polysaccharides and polysaccharide-containing compositions, it would constitute an undue and unpredictable experimental burden.

Genentech, 108 F.3d at 1366, states that, "a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion." And "patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable."

Therefore, in view of the Wands factors, as discussed above, particularly the breadth of the claims, Applicants fail to provide information sufficient to practice the claimed invention for all possible polysaccharides.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Inohara et al. (WIPO Publication WO 2003/013612, published 20 Feb 2003, provided by Applicant in IDS mailed 03 May 2006). As this document is in Japanese, US Patent Application Publication 2004/0266725 (cited in PTO-892) is provided as an English language equivalent and is referred to as Inohara et al. herein.

Inohara et al. discloses a composition containing a polysaccharide in water (abstract). Inohara et al. discloses a composition containing the 0.1 wt % of the polysaccharide agar in water (page 2, paragraph 26), meeting limitations of instant claims 1-5.

Inohara et al. is silent as to the amount of precipitated polysaccharide after performing centrifugal separation at 25 °C with 40,000x g for one hour. However, it is apparent from what is disclosed that this property is inherent to the identical chemical composition disclosed by Inohara et al. Products of identical chemical composition can not have mutually exclusive properties, see MPEP 2112.01 II. It is noted that *In re Best*, 562 F.2d 1252, 195 USPQ 430 (C.C.P.A. 1977) and *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (C.C.P.A. 1980) discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess the characteristic relied on" (205 USPQ 594, second column, first full paragraph).

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al. (Cereal Chemistry, 1975, 52, p70-78, cited in PTO-892). Evidence of inherent properties is provided by the Merck Index (entry for Dextri-Maltose, Merck Index, cited in PTO-892).

Johnson et al. discloses a solution of a maltooligosaccharide G₁ in water diluted to 1% concentration (page 71, paragraph 3 and page 73, paragraph 1). As evidenced by the Merck Index, maltose and dextrans produced from corn flour are readily soluble in water.

Johnson et al. is silent as to the amount of precipitated polysaccharide after performing centrifugal separation at 25 °C with 40,000x g for one hour. However, it is apparent from what is disclosed that the maltooligosaccharide G₁ solution disclosed by Johnson et al., being readily soluble in water, will necessarily remain in solution upon centrifugation. It is noted that *In re Best*, 562 F.2d 1252, 195 USPQ 430 (C.C.P.A. 1977) and *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (C.C.P.A. 1980) discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess the characteristic relied on" (205 USPQ 594, second column, first full paragraph).

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (Cereal Chemistry, 1975, 52, p70-78, cited in PTO-892).

Johnson et al. discloses as above.

Johnson et al. does not specifically disclose a composition wherein the polysaccharide has a concentration of from 0.0002 to 0.5 wt% (instant claim 5).

Johnson et al. provides guidance for diluting the sample in water to reduce the concentration (page 73, paragraph 1). Johnson et al. provides guidance for reducing the concentration to 0% w/v (page 75, figure 2 at bottom of page).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Johnson et al. to give a composition wherein the

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polysaccharide has a concentration of from 0.0002 to 0.5 wt%. Johnson et al. provides guidance for diluting the sample to a concentration of 0% w/v. One of ordinary skill in the art would have been motivated to reduce the concentration to vary specific viscosity to the limiting value determined by Johnson et al.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-16, 50, 51 and 52 of copending Application No. 10/486122, published as US Patent Application Publication 2004/0266725 cited in the 102(b) rejection above. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

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The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: Claims 1-16, 50, 51 and 52 are drawn to a composition comprising a polysaccharide, such as agar, and water wherein the polysaccharide is present in an amount from 0.1 wt% (claims 1, 2, 4-16, 50, 51 and 52) and 0.2 wt% (claim 3).

MPEP 2121.01 discusses the use of prior art in rejections where operability is in question. Even if a reference discloses an inoperative device, it is prior art for all that it teaches.

The claims of copending Application No. 10/486122 are silent as to the amount of precipitated polysaccharide after performing centrifugal separation at 25 °C with 40,000x g for one hour. However, it is apparent from what is disclosed that this property is inherent to the identical chemical composition claimed in copending Application No. 10/486122. Products of identical chemical composition can not have mutually exclusive properties, see MPEP 2112.01 II. It is noted that *In re Best*, 562 F.2d 1252, 195 USPQ 430 (C.C.P.A. 1977) and *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (C.C.P.A. 1980) discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess the characteristic relied on" (205 USPQ 594, second column, first full paragraph).

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claims 1-5 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-13 of copending Application No. 11/810524. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: Claims 1-13 of copending Application No. 11/810524 are drawn to a composition comprising a polysaccharide agar and water wherein the agar is in an amount from 0.1 wt% (claim 4) and 0.2 (claim 5).

The claims of copending Application No. 11/810524 are silent as to the amount of precipitated polysaccharide after performing centrifugal separation at 25 °C with 40,000x g for one hour. However, it is apparent from what is disclosed that this property is inherent to the identical chemical composition claimed in copending Application No. 11/810524. Products of identical chemical composition can not have mutually exclusive properties, see MPEP 2112.01 II. It is noted that *In re Best*, 562 F.2d 1252, 195 USPQ

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430 (C.C.P.A. 1977) and *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (C.C.P.A. 1980) discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess the characteristic relied on" (205 USPQ 594, second column, first full paragraph).

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

No claim is found to be allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan S. Lau whose telephone number is 571-270-3531. The examiner can normally be reached on Monday - Thursday, 9 am - 4 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia Anna Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jonathan Lau
Patent Examiner
Art Unit 1623

/Shaojia Anna Jiang/
Supervisory Patent Examiner
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